

DOCKET NO.: 282532US8X/brf

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 2161

David W. TREPESS, et al.

SERIAL NO: 10/723,086

EXAMINER: DAYE, CHELCIE L.

FILED: November 25, 2003

FOR: INFORMATION STORAGE AND RETRIEVAL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

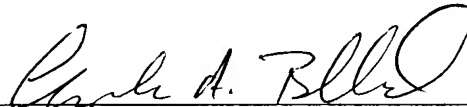
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Appellant respectfully requests that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

I. FAILURE TO PRESENT A *PRIMA FACIE* CASE OF OBVIOUSNESS

Appellants submit that the Final Office Action of November 3, 2009 (hereinafter “Final Action”) has failed to provide a *prima facie* case of obviousness under 35 U.S.C. § 103 with respect to Claims 1-10, 12, 13, 15, 17-28, and 33-44 of the present application.¹

The rejection of each of Claims 1-10, 12, 13, 15, 17-28, and 33-44 relies, at least in part, on the Washingtonian screenshots. However, the Washingtonian screenshots do not qualify as prior art with respect to the present application.

¹ See the Final Action at pages 2-16, detailing the rejection of Claims 1, 2, 4, 5, 7, 8, 10, 12, 13, 15, 17, 18, 23, 26-28, 33, 34 36-38 and 40-44 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 6,990,238 to Saffer et al. (herein “Saffer”) in view of Xia Lin, et al., “A Self-Organizing Semantic Map ...” (herein “Lin”) and screen shots from the website www.washingtonian.com (hereinafter, “the Washingtonian screenshots”); the rejection of Claims 3, 6, 9, 19, 20, 24, 25, 35 and 39 under 35 U.S.C. § 103(a) as unpatentable over Saffer in view of Lin, U.S. Patent No. 6,446,061 to Doerre et al. (herein “Doerre”) and the Washingtonian screenshots; and the rejection of Claims 21 and 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over Saffer in view of Lin, the Washingtonian screenshots, Doerre, and U.S. Patent 5,977,992 to Branscomb.

The Office Action makes reference to four screen shots, and lists the following websites in Form PTO-892:

<http://www.washingtonian.com/articles/people/6650.html> (hereinafter, “website A”)

<http://www.washingtonian.com/articles/people/6490.html> (hereinafter, “website B”)

In rejecting Claims 1-10, 12, 13, 15, 17-28, and 33-44, the Final Action relies on functional aspects of website A and website B.² Website A includes an article titled “Divorce, Washington-Style” and a statement that the article was “Published Wednesday, March 01, 2000.” Website B includes an article titled “Need a GOOD Lawyer?” and a statement that the article was “Published Monday, April 01, 2002.” Regardless of when the articles on website A or website B were originally published, the original publication dated of these articles are not evidence of when the functional aspects of the website that currently display these articles were originally incorporated into the website, and thereby made known to the public. Indeed, the publication dates of the articles on these websites may have been dates that these articles appeared in an entirely different media, such as the printed version of the Washingtonian magazine that appears on newsstands.

Nevertheless, the Examiner asserts in a footnote on pages 5-6 of the Final Action that “Screen Shots have been provided for Washingtonian.com that was published within 2000 and 2002.” This statement may be correct with respect to the articles on website A and website B, but is not correct with respect to the functional aspects of website A and website B that the Final Action relies on to reject Claims 1-10, 12, 13, 15, 17-28, and 33-44.

M.P.E.P. § 2128 does allow for prior art disclosures on the Internet or on an on-line database to be considered to be publicly available as of the date the item was publicly posted.

² See, for example, the Final Action at page 5, lines 9-15.

However, absent evidence of the date that the disclosure was publicly posted, if the publication itself does not include a publication date (or retrieval date), M.P.E.P. § 2128 makes it clear that the publication cannot be relied upon as prior art.

In the present case, the Final Action asserts that various functional aspects of the noted websites (for examples, the arrows that indicate previous and next page) disclose features recited in the claims of the present application, but then relies on the publication date of the content on these websites as evidence of the date the functional aspects were known. However, the date the content, in this case an article on the website, was originally published is not evidence of when the functional aspects of the website that currently display that content were originally incorporated into the website, and thereby made known to the public.

With respect to publication dates, website A and website B are each current websites that respectively include articles which the websites indicate were published on March 01, 2000 and April 01, 2002. Although the contents of the articles can be relied upon as being publicly available as of these publication dates, the publication date of the article is not evidence that the websites themselves, including all of their functional elements, were available at the time these article were originally posted. For example, the U.S. PTO recently rolled out a new website that republishes numerous articles that are very old using the latest functional display components. The original publication date of each of these articles might, in some circumstances, be used as evidence for when these articles were first available to the public, but in no way evidences when the website itself, as it currently appears was initially launched.

The present application claims priority to GB0227683.0, which was filed on November 27, 2002. The Final Action fails to provide any credible evidence as to when the

functional aspects of website A and website B made known to the public. Accordingly, the Washingtonian screenshots do not qualify as prior art with respect to the aspects relied on by the Examiner to reject Claims 1-10, 12, 13, 15, 17-28, and 33-44 of the present application.

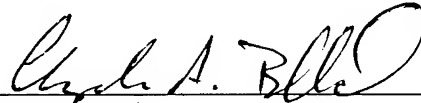
Accordingly, the rejections of Claims 1-10, 12, 13, 15, 17-28, and 33-44 that rely on the Washingtonian screenshots are improper.

II. CONCLUSION

Appellants respectfully submit the U.S. PTO has failed to establish a *prima facie* case of obviousness in view of the clear factual and legal deficiencies outlined above. Accordingly, it is respectfully requested the Final Action dated November 3, 2009 be WITHDRAWN. A Notice of Allowance for Claims 1-10, 12, 13, 15, 17-28, and 33-44 is earnestly solicited.

Respectfully submitted,

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